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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,952	10/22/2001	Rainer Stademann	112740-241	4243
29177	7590	02/24/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC			AL AUBAIDI, RASHA S	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			2642	
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,952

Applicant(s)

STADEMANN, RAINER

Examiner

Rasha S AL-Aubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/07/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9, 11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the limitation "operation". Also, examiner is unable to determine operation of what exactly?

Dependent claims 10 and 12 are rejected for the same reason as independent claims 9 and 11.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-10 and 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 9, 13 and 14 claim an information element component of a signaling message, which is not a statutory subject matter under 35 U.S.C 101.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Galloway et al (US PAT # 5,940,492).

Regarding claim 9, Galloway teaches an information element component of a signaling message (see col. 2, lines 6-10 and col. 4, lines 1-19) used for signaling between exchanges in a communication network (see col. 4, lines 4-11), comprising: an administration component via which services for which the information element is used can be stipulated during operation (this basically reads on the element fixed part 46 in the signaling message, see for example, Fig. 3 and Fig. 4); and content values which can be at least one of evaluated and altered, based on a preset value made using the administration component, within the context of processing a connection by an exchange (this reads on the variable part 47, see for example, Fig. 3 and Fig. 4, see also, col. 3, lines 60-67).

Claims 11 and 14 are rejected for the same reasons as discussed above with respect to claim 1. Also, for the claimed "characteristics by which the administration component can be used to embed into a connection control", as recited in claim 14, is inherent as long as the information and/or the parameter is fixed.

Regarding claims 10 and 12, Galloway teaches the administration component (reads on the fixed part 46, in Figs. 3 and 4 also, see Fig. 2 and col. 2, lines 16-26) makes the stipulation by embedding a respective information item for at least one bit position of the information element as a control information item into a connection control of the exchange (this basically reads on having some mandatory information contained in the message as shown in Figs. 2, 3, and 4 and this information will control the routing of the signaling message, see also, col. 4, lines 22-53).

Regarding claim 13, Galloway teaches an administration component of an information element (reads on the mandatory fixed part such as part 46 in Figs. 3-4) of a signaling message used for signaling between exchanges in a communication network, comprising characteristics (this reads on the mandatory protocol class parameter, see col. 4, lines 4-13) by which the administration component can be used to impress on a connection control of an exchange during operation, services for which the information element is used (this limitation is inherent, since the information or the parameter is fixed).

Regarding claim 15, Galloway teaches a method for connection control in an exchange of a communication network, the method comprising the steps of: impressing manipulator functions administratively on the connection control at particular execution locations (this reads the certain requests and services, see col. 1, lines 44-57 and col. 2, lines 16-30); and prompting actions via the manipulator functions which can at least one of alter and evaluate content values of information elements of signaling messages (this basically reads on receiving or presenting the requests to the requester, this is inherent).

Claim 16 is rejected for the same reasons as discussed above with respect to claim 15. Also, having “an administration component for programming a function” is inherent.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen et al (US PAT # 5,943,408) teaches a direct signaling system for allowing system subscribers to access service providers of their choice, regardless of their access network arrangement (see abstract).

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McDaniel et al (US PAT # 6,175,732) teaches telecommunication system have the capability to remote feature control like changing the service feature such as "call forwarding" (see abstract).

Shobatake (US PAT # 6,772,219) teaches message relying scheme within the signaling message a first half portion is fixed and the second half portion should preferably be variable (see abstract also col. 30, lines 25-55)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703) 605-5145. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar, can be reached on 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR


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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner

Rasha S. Al-Aubaidi

02/18/2005



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